

REMARKS/ARGUMENTS

Applicants have received and carefully reviewed the Office Action of the Examiner mailed April 3, 2008. Claims 1-29 remain pending. Claims 1, 13, 14, and 27 have been amended. Support for the amendments may be found in the specification, claims and drawings as filed. No new matter has been added. Reconsideration and reexamination are respectfully requested.

Response to Arguments

In paragraph 4 of the Office Action, the Examiner states that Applicants' arguments with respect to claims 1-27 are moot in view of the new ground of rejection. It appears, however, that all of the rejections in the current Office Action are simply repeated from the last Office Action. Applicants respectfully request that the Examiner provide a response to the remarks/arguments previously presented in the Amendment dated December 21, 2007 in a subsequently issued Non-Final Office Action in order for Applicants to have the opportunity to respond.

Rejection under 35 U.S.C. § 112

Claim 27 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner states, "[r]egarding claim 27, the phrase 'can', which renders the claim indefinite. It is unclear whether the limitation(s) following the phrase are part of the claimed invention." Applicants respectfully disagree.

Applicants submit that the word "can" provides a positive recitation, and is completely consistent with 35 U.S.C. §112, second paragraph. Claim 27 recites: determining which of the acceptable activity parameters can be changed by the supervisor, resulting in one or more changeable activity parameters". A search of patents issues since 1975 at the USPTO website for the word "can" in the claims resulted in 382,071 hits. Clearly, the word "can" is not prohibited from being used in a claim. In any event, claim 27 has been amended to recite "determining which of the acceptable activity parameters are changeable ~~can be changed~~ by the

supervisor, resulting in one or more changeable activity parameters”. It is believed that the removal of the word “can” renders the Examiner’s rejection moot. Reconsideration and withdrawal of the rejection are respectfully requested.

Rejection under 35 U.S.C. § 102(e)

On page 2, paragraph 5 of the Office Action, the Examiner has defined the basis for rejections under 35 U.S.C. §102. The Examiner continues on page 3, stating in paragraph 6, “[c]laims 14, 16-18, 20-21 and 27 are rejected under 35 U.S.C. 103(a) as being anticipated by Lafore et al. ‘Lafore’ (US 2002/0032640).” It is unclear under which section the Examiner meant to reject the claims. In the interest of furthering prosecution, it will be assumed the claims were meant to be rejected under 35 U.S.C. §102(e). Clarification is respectfully requested.

Claims 14, 16-18, 20, 21, and 27 are rejected as being anticipated by Lafore et al. (US 2002/0032640). Applicants respectfully traverse the rejection.

Claim 14, as amended, recites:

14. (Currently Amended) A method for providing a report used by a supervisor for supervising the activities of a number of representatives of a business, wherein each of the number of representatives records his/her activities in the database, the method comprising:

identifying one or more unacceptable activities;

defining one or more unacceptable activity parameters for detecting the one or more unacceptable activities when the report is run against the database, wherein the defined one or more unacceptable activity parameters are stored in the database;

determining which of the unacceptable activity parameters can be changed by the supervisor, resulting in one or more changeable activity parameters; and

generating the report, the report including the one or more unacceptable activity parameters including one or more of the changeable activity parameters.

As can be seen, claim 14 recites a method that includes a number of interrelated method steps. It is axiomatic that when evaluating the scope of a claim, every element in the claim must be considered, and office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered. This is particularly true in a process claim because a new combination of steps in a process may be patentable even though all the constituents of the combination were well known and in common

use before the combination was made. (see MPEP § 2106, II (C) and, e.g., *Diamond v. Diehr*, 450 U.S. at 18889, 209 USPQ at 9). In the present case, the recited method of claim 14, when taken as a whole, is believed to be clearly patentable over Lafore et al., and many of the recited steps are clearly distinguished from Lafore et al.

Turning to the first two recited steps of claim 14, Lafore et al. do not appear to teach or suggest identifying one or more unacceptable activities, and defining one or more unacceptable activity parameters for detecting the one or more unacceptable activities when the report is run against the database, wherein the defined one or more unacceptable activity parameters are stored in the database.

The Examiner asserts that Lafore et al. teach identifying one or more unacceptable activities, pointing to paragraphs 0012 and 0015 for support. Applicants have found no such teaching in Lafore et al. Paragraph 0012 appears to teach the five main components of the Lafore et al. data processing system including: (1) main server database as a central repository for data entered into the system; (2) means for processing data allowing for broker trade information to be handled by e-mail; (3) “branch manager’s version” of software allowing a user to retrieve client and trade information and approve or reject trade records of various broker representatives; (4) “DBMS Administrator” software for security purposes that establishes the authorized levels of use in the system; and (5) “regional compliance director’s version” allowing a user to review trade records of one or more branches. Lafore et al. do not appear to teach or suggest identifying one or more unacceptable activities, and defining one or more unacceptable activity parameters for detecting the one or more unacceptable activities when the report is run against the database, wherein the defined one or more unacceptable activity parameters are stored in the database, as recited in claim 14.

In response to Applicants’ previous arguments, the Examiner asserts, “[s]ince the representative’s information is modified by the branch manager/supervisor, it implies that the representative performed an unacceptable activity which not within a parameter.” The Examiner thus appears to be alleging that Lafore et al. somehow inherently includes the missing elements. However, in accordance with M.P.E.P. § 2112(IV), the Examiner must provide rationale or evidence tending to show inherency. Also, “[t]he fact that a certain result or characteristic may

occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” The missing material must necessarily be present. Lafore et al. do not appear to teach or suggest what information is being modified. Just because the branch manager/supervisor is capable of modifying information, it does not mean that an unacceptable activity was performed. The branch manager may merely be correcting a typographical error or client information. Lafore et al. do not appear to teach or suggest identifying one or more unacceptable activities as recited in claim 14.

Paragraph 0015 of Lafore et al. states:

[0015] In summary, the data processing system provides electronic means for recording and monitoring all stockbroker transaction information. The data processing system maintains records on client information such as names, addresses, types of investments, trade activity, funds availability, investment objectives, as further discussed below. In addition, the data processing system generates reports on daily trade activity, production/activity by stock broker, activity by client and by almost any other category which has been designated a data field within the data processing system.

If the Examiner is equating the branch manager’s version of software allowing the manager to approve or reject trade records to the claimed step of identifying one or more unacceptable activities, Applicants respectfully disagree. The above-cited paragraphs of Lafore et al. appear to teach software that allows a branch manager to approve or reject a trade, but does not teach or suggest that this involves anything regarding unacceptable activities. A trade could be rejected for any number of reasons, and absent any teaching that unacceptable activity is the basis for such a rejection, these paragraphs of Lafore et al. cannot be seen to anticipate the specific claimed method step. The Examiner is reminded that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ... “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (see, MPEP § 2131).

The Examiner also asserts that Lafore et al. teaches the steps of defining one or more unacceptable activity parameters for detecting the one or more unacceptable activities when a

report is run against the database, and determining which of the unacceptable activity parameters can be changed by the supervisor, citing paragraphs 0013 and 0102. Applicants respectfully disagree. Paragraph 0013 of Lafore et al. states:

[0013] Thus, for the first embodiment on the WindowsTM version, the data is entered on remote work stations, stored in local databases until the user performs a data transmission function which electronically transfers the data to a central database. The central database acts as a central repository enabling multiple off-site users to view and/or modify data, and generate reports or output which may be required by the SEC.

This paragraph appears to merely teach that the data is entered on remote work stations, is stored in local databases, and transferred electronically to a central database. Further, claim 14 has been amended to further clarify the defined one or more unacceptable activity parameters are stored in the database. Lafore et al. clearly do not appear to teach or suggest this feature.

Paragraph 0102 states:

[0102] The last user level which may be designated is the inactive user level. This inactive user level may be designated for any number of reasons, for example, a broker representative who has recently quit the particular brokerage house and has moved to another job must be differentiated from a representative still employed. Another situation in which the inactive user level could be activated is when there is suspicion of improper trade activity being conducted by a particular broker representative. In either case, the administrator may designate any user to be placed in the inactive status which prevents that particular user from any system access. Each time any user, to include an administrator, attempts to log on the system, an authentication takes place wherein the unique user ID, user level and password, as well as matching the system ID number, are verified by the DBMS Administrator software. A user who attempts to log on without correct identification will be denied access. As well understood by those skilled in the art, various error messages can be displayed at the particular user screen or display which indicate that access is denied for failure to enter the correct authentication data.

This paragraph of Lafore et al. appear to merely teach that the system has a security log-in procedure in which users have various levels of access to the databases, and one level is inactive, which prevents the user from any system access.

In contrast, claim 14 recites:

14. (Currently Amended) A method for providing a report used by a supervisor for supervising the activities of a number of representatives of a business, wherein each of the number of representatives records his/her activities in the database, the method comprising:

identifying one or more unacceptable activities;

defining one or more unacceptable activity parameters for detecting the one or more unacceptable activities when the report is run against the database, wherein the defined one or more unacceptable activity parameters are stored in the database;

determining which of the unacceptable activity parameters can be changed by the supervisor, resulting in one or more changeable activity parameters; and

generating the report, the report including the one or more unacceptable activity parameters including one or more of the changeable activity parameters.

The cited paragraphs of Lafore et al. do not teach many of these steps, and also do not teach the recited method taken as a whole. For example, the cited paragraphs of Lafore et al. do not teach the steps of identifying one or more unacceptable activities, and then defining one or more unacceptable activity parameters in the database for detecting the one or more unacceptable activities when the report (that is generated by the generating step) is run against the database, and wherein the defined one or more unacceptable activity parameters are stored in the database. Instead, and if anything, it would appear that the “branch manager’s version” of software of Lafore et al. merely leaves it to the discretion of the branch manager to approve or reject trade records of the various broker representatives. As such, Lafore et al. would appear to teach away from defining one or more unacceptable activity parameters, particularly for detecting the one or more unacceptable activities when a report (that is generated by the generating step) is run against the database, and certainly would not teach storing the defined one or more unacceptable activity parameters in the database, as recited in claim 14.

Lafore et al. also do not appear to teach the steps of determining which of the unacceptable activity parameters can be changed by the supervisor, resulting in one or more changeable activity parameters. The Examiner cited to paragraph 0016 of Lafore et al. as teaching this step. Paragraph 0016 of Lafore et al. states:

[0016] Some specific functional aspects of the data processing system of this invention include the ability to monitor and record any and all data changes made to previously entered trade records. This audit function prevents the changing of any trade record data without some record being made thereof in the main

database. This is an additional security feature which further ensures that all data is entered and recorded, whether it be the entry of original data for a trade transaction, or necessary changes which sometimes need to be made to trade data. A trade audit report may be generated which shows a change status with regard to each trade record.

This paragraph appears to merely suggest including an audit function for all data changes in the main database. The audit function appears to record changes that are made to the database. This certainly cannot be considered as teaching the specific method step of determining which of the unacceptable activity parameters can be changed by the supervisor, resulting in one or more changeable activity parameters, particularly for unacceptable activity parameters defined by a defining step such as in claim 14, and which are for detecting one or more unacceptable activities when the resulting report is run against the database. Nor does it appear that Lafore et al. teaches, discloses or suggests the step of generating such a report, particularly where the report includes the one or more unacceptable activity parameters, including one or more changeable activity parameters.

In response to the Applicants' previous arguments, the Examiner asserts, "Lafore teaches the concept of generating a report of trade activity of a representative which shows unacceptable activity of the representative; and since the report is generated, it implies that the representative unacceptable activities were run in the database which shows unacceptable activities of performed by the representative." As discussed above, Lafore et al. clearly teach the determination of the acceptable/unacceptable activity is left to the discretion of the branch manager. Nowhere do Lafore et al. teach or suggest defining unacceptable activities, and more specifically, defining one or more unacceptable activity parameters for detecting the one or more unacceptable activities when the report is run against the database, and wherein the defined one or more unacceptable activity parameters are stored in the database, as recited in claim 14. If the unacceptable activities are not defined, Lafore clearly cannot teach or suggest generating a report including the unacceptable activities parameters that can then be run against the database.

If the Examiner is considering the specific method steps recited in the claims to be inherent in Lafore et al., Applicants submit that there is no basis for such an interpretation. MPEP 2112 IV. states:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is **necessarily present** in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)...(emphasis added)

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

Applicants submit that the claimed method steps, in particular the steps of identifying one or more unacceptable activities, defining one or more unacceptable activity parameters for detecting the one or more unacceptable activities when the report is run against the database, wherein the defined one or more unacceptable activity parameters are stored in the database; determining which of the unacceptable activity parameters can be changed by the supervisor, and generating the report, where the report including the one or more unacceptable activity parameters including one or more of the changeable activity parameters, are clearly not necessarily present in Lafore et al. It appears the Examiner may be asserting that the claimed method steps could be performed by the system of Lafore et al., which is not a proper basis for an anticipation rejection. For these and other reasons, claim 14 is believed to be clearly patentable over Lafore et al. For similar and other reasons, dependent claims 16-18 and 20-21 are also believed to be clearly patentable over Lafore et al. For similar and other reasons, independent claim 27 is also believed to be clearly patentable over Lafore et al. Reconsideration and withdrawal of the rejection are respectfully requested.

Rejection under 35 U.S.C. § 103(a)

Claims 1, 2, 4-13, 15, 19, and 22-26, and 29 are rejected as being unpatentable over Lafore et al. in view of Dialog (Penny Stock Disclosure Rules). Applicants respectfully traverse the rejection. Turning first to claim 1 which, as amended) recites:

1. (Currently Amended) A method for providing supervision over the activities of a number of representatives of a business, the method comprising the steps of:

providing a database, each of the number of representatives recording his/her activities in the database;

providing a number of reports, each report defining a number of unacceptable activity parameters, wherein the number of reports are stored in the database;

running the number of reports against at least part of the database, each report checking the recorded activities of each representative against the number of unacceptable activity parameters defined in the report; and

providing a listing of alerts for only those activities in the database that fall within the unacceptable activity parameters defined in the number of reports.

Lafore et al. clearly do not teach many of these steps. For example, and as detailed above, the cited passages of Lafore et al. clearly do not teach the step of providing a number of reports, each report defining a number of unacceptable activity parameters, wherein the number of reports are stored in the database. Instead, and if anything, the “branch manager’s version” of software of Lafore et al. would appear to leave it to the discretion of the branch manager to approve or reject trade records of the various broker representatives. Lafore et al. do not appear to provide any information or suggestion as to what criteria are used to determine what would be considered improper trade activity or the like. Lafore et al. would thus appear to teach away from providing a number of reports, where each report defines a number of unacceptable activity parameters, and wherein the number of reports are stored in the database, as recited in claim 1, particularly when taken in light of the running step, which recites running the number of reports against the database, where each report checks the recorded activities of each representative against the number of unacceptable activity parameters defined in the report.

Notably, Lafore et al. do not teach running a number of reports against the database, where each report checks the recorded activities of each representative against the number of unacceptable activity parameters defined in the report. Instead, and as noted above, the “branch manager’s version” of the Lafore et al. software would appear to leave it to the discretion of the

branch manager to approve or reject trade records of the various broker representatives. In addition, Lafore et al. do not appear to teach providing a listing of alerts for only those activities in the database that fall within the unacceptable activity parameters defined in the number of reports. Further, nowhere do Lafore et al. appear to teach or suggest the use of reports of any kind, wherein each report defines a number of unacceptable activity parameters.

Dialog appears to be a set of rules under the Securities Exchange Act of 1934 meant to regulate broker/dealer transactions. Providing a set of rules does not guarantee one will abide by such rules, nor do the rules teach or suggest methods for ensuring compliance. Thus, one of ordinary skill in the art would not look to Dialog to solve the problem at hand.

As detailed above, Lafore et al. clearly do not teach many of the steps of claim 1. In addition, there would appear to be no motivation or reason whatsoever for one of ordinary skill in the art to modify the system and method of Lafore et al. to achieve the claimed method steps. Moreover, Dialog does not appear to teach what Lafore et al. lack. Thus, even if one were to combine Lafore et al. and Dialog, one would not arrive at the specific method recited in claim 1. For these and other reasons, claim 1 is believed to be clearly patentable over Lafore et al. in view of Dialog. For similar and other reasons, claims 2, 4-13, 15, 19, 22-26 are also believed to be clearly patentable over Lafore et al. in view of Dialog.

Specifically regarding claim 10, the Examiner asserts that Lafore discloses providing compliance related materials to a user, referring to sending compliance message to a representative, asserted to be taught in paragraph 0113. This paragraph in Lafore et al. appears to teach a procedure in which e-mail is sent from a broker to the branch manager for approval before being forwarded to a client. Lafore et al. state, "E-mail generated by the broker which is not approved by the branch manager may also be placed in a file in the form of a compliance report document within the main database." Applicants submit that this non-approved e-mail message is not "compliance related materials" as recited in claim 10. Rather, Lafore et al. appear to be teaching that a non-approved e-mail is sent to a particular part of the database in the form of a compliance report. No "compliance related materials" appear to be provided to the user. Similarly, with respect to claims 11 and 12, because Lafore et al. do not appear to provide compliance related materials to the user, there is no motivation for one of ordinary skill in the art

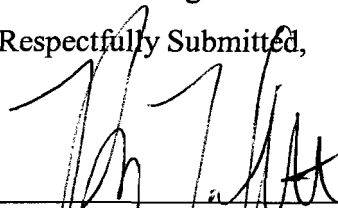
to keep track or record when a user receives such material.

As indicated in the responses dated September 21, 2007 and December 21, 2007, the Examiner appears to be taking Official Notice with respect to claims 19 and 23-26, asserting that the claimed unacceptable activities are well known and expected in the art. The Examiner did not address this in the Office Action mailed April 3, 2008. Applicants submit that the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. Per MPEP 2144.04(C), Applicants respectfully traverse the taking of Official Notice and request that the Examiner provide documentary evidence supporting the rejection in the next office action if the rejection is maintained. Reconsideration and withdrawal of the rejection are respectfully requested.

Claim 3 is rejected as being unpatentable over Lafore et al. in view of Dialog, and further in view of Yong et al. (US 5,749,079). For at least the reasons set forth above, the combination of Lafore et al. and Dialog does not appear to teach or suggest the basic elements of independent claim 1, from which claim 3 depends. Yong et al. do not appear to teach or suggest what Lafore et al. and Dialog lack. Dependent claim 3 recites further elements not taught or suggested in Lafore et al., Dialog, or Yong et al., or a combination thereof. Reconsideration and withdrawal of the rejection are respectfully requested.

Reconsideration and reexamination are respectfully requested. It is submitted that, in light of the above remarks, all pending claims are now in condition for allowance. If a telephone interview would be of assistance, please contact the undersigned attorney at 612-359-9348.

Respectfully Submitted,



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Date: July 2, 2008